

REMARKS

STATUS OF THE CLAIMS:

Claims 1-7, 9-20 have been pending of which claims 1-7, 9-12 and 20 have been elected and claims 13-19 have been withdrawn.

Claims 1-7, 9-12 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-4, 6-7 and 9-12 and 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over DiMattina, U.S. Patent No. 6,405,177, hereinafter "DiMattina", in view of Furusawa et al., U.S. Patent No. 6,937,738, hereinafter "Furusawa".

Claim 5 is rejected under 35 U.S.C. § 103(a) as being unpatentable over DiMattina, in view of Furusawa, in further view of Margoscin et al., U.S. Patent No. 7,003,482.

In accordance with the foregoing, claim 1 is cancelled without disclaimer or prejudice, the claims are amended, and, thus, the pending claims remain for reconsideration, which is respectfully requested.

No new matter has been added.

The Examiner's rejections are respectfully traversed.

35 U.S.C. §112 REJECTION:

The Office Action, at items 5-6, rejects claims 1-7, 9-12 and 20 under 35 U.S.C. § 112, second paragraph, as being indefinite for reciting the phrase "buyer and/or seller." In accordance with the foregoing, the claims are amended, taking into consideration the Examiner's comments.

The Office Action, at items 7-8, rejects claim 20 under 35 U.S.C. §112, second paragraph, because the claimed "electronic commerce information" and "transmitted transactional information" lacked proper antecedent basis. In accordance with the foregoing, claim 20 is amended, taking into consideration the Examiner's comments.

Applicants respectfully submit that claims 1-7, 9-12 and 20 comply with the requirements of 35 U.S.C. § 112, second paragraph. Accordingly, withdrawal of the 35 U.S.C. § 112, second paragraph, claim rejection is respectfully requested.

35 U.S.C. § 103(a) REJECTION:

Independent claims 4, 6, 9-12 and 20 are allegedly unpatentable over DiMattina in view of Furusawa.

In accordance with the foregoing, claim 4 is amended into independent form including all of the features of independent claim 1, and recites "wherein said distributing distributes the solicitation-to-insurance information from an insurer selected corresponding to contents of the electronic information." Independent claimed 6, 9-12 and 20 are amended requiring the feature of dependent claim 4. The Office Action, at item 14, asserts that DiMattina discloses dependent claim 4 at column 3, lines 47-55.

Applicants respectfully disagree with the assertion, because DiMattina at column 3, lines 47-55 recites:

In accordance with the preferred embodiment, the provided on-line transaction insurance system will work in cooperation with the various electronic retailers which will modify their websites by implementing a call to the insurance provider's URL (Uniform Resource Locator) or WWW address. As shown in FIG. 1, the insurance provider will pay rent to the electronic retailer in exchange for this cooperation.

In other words, DiMattina discusses that a retailer will modify its website to implement a call to the insurer's URL, and the insurer will pay the retailer rent for cooperating. However, Applicants respectfully submit that DiMattina fails to disclose, either expressly or implicitly, the claimed "wherein said distributing distributes the solicitation-to-insurance information from **an insurer selected corresponding to contents of the electronic information**," as recited, for example, in claim 4, because DiMattina merely discusses making a call to an insurers URL when a user makes a purchase on the retailers website. In other words, DiMattina fails to disclose that an insurer is selected corresponding to the contents of the electronic information. One benefit of the embodiment according to claim 4, for example, is that an insurer can be selected corresponding to contents of the electronic information, for example, the item being sold, the type of transaction, the price of the transaction (see, for example, FIG. 7).

Furthermore, Furusawa merely discusses "a message processing apparatus which processes received messages according to their content" (Furusawa, column 1, lines 47-49), and, thus, Applicants respectfully submit that Furusawa fails to overcome the deficiencies of DiMattina.

Accordingly, Applicants respectfully submit that a *prima facie* case of obviousness cannot be based upon DiMattina and Furusawa, because there is no evidence that one skilled in the art would modify DiMattina, Furusawa or a combination DiMattina and Furusawa to include the claimed “wherein said distributing distributes the solicitation-to-insurance information from an insurer selected corresponding to contents of the electronic information,” as recited, for example, in claim 4, and see the benefit of selecting an insurer corresponding to the contents of the electronic information.

Furthermore, the Office Action, at item 24, acknowledges that in DiMattina “the entire insurance process is implemented by a cooperation between the retailer and the insurer in which the retailer’s website is modified to implement a call to the insurance providers web address in exchange for payment.” See also, for example, DiMattina at column 3, lines 48-55, which recites:

... the provided on-line transaction insurance system will work in cooperation with the various electronic retailers which will modify their websites by implementing a call to the insurance provider’s URL (Uniform Resource Locator) or WWW address. As shown in FIG. 1, the insurance provider will pay rent to the electronic retailer in exchange for this cooperation.

Claim 4 is amended to recite “cross-checking, by a server operated by a service dealer other than a buyer, a seller and an insurance company, electronic information distributed within the server between the buyer and the seller with a word table in which a solicitation-related keyword is registered, and judging whether the solicitation-related keyword is included in the electronic information; and distributing solicitation-to-insurance information to the buyer, the seller or both, when judged by the server that the solicitation-related keyword is included in the electronic information.” Support for the claim amendment can be found, for example, in FIG. 2A and in the specification, at page 8, lines 18-24.

Applicants respectfully submit that DiMattina at least fails to disclose, either expressly or implicitly, the claimed “cross-checking, by a server operated by a service dealer other than a buyer, a seller and an insurance company, electronic information distributed within the server between the buyer and the seller,” as recite in the embodiment in claim 4, because, as acknowledged by the Examiner, DiMattina is related to a retailer’s website which is modified to implement a call to the insurance providers web address.

Furthermore, Furusawa discusses “a message processing apparatus which processes received messages according to their content” (Furusawa, column 1, lines 47-49). Furusawa further discusses “[t]he distributing station 40 has a keyword lookup table that defines the relationships between message keywords and their associated handler programs” (Furusawa,

column 5, lines 21-23). In other words, Furusawa discusses a keyword lookup table to flag or classifies how each email is to be handled in a handler program. Accordingly, Applicants respectfully submit the Furusawa fails to overcome the deficiencies of DiMattina.

The Office Action, at item 11, asserts that "it would have been obvious to one skilled in the art at the time of the invention to incorporate such keyword lookup functionality into the systems of DiMattina. One of ordinary skill in the art would have been motivated to incorporate such a feature for the purpose of providing uniformity in the message processing of DiMattina." Applicants respectfully disagree with the assertion.

DiMattina discusses "[t]he initial stage of the insurance system . . . is initiated when the purchaser elects to submit the items that he/she has chosen to buy. At this point a question will be asked, 'Do you wish to secure this transaction?' Along with this question a list of all the benefits offered by electing to secure the transaction will be presented to the purchaser" (Dimattina, column 3, lines 56-60). In other words, DiMattina is directed to a method for a retailer to offer insurance to customers when the customer submits an order. Thus, DiMattina uses the customers submission as a trigger for offering insurance.

The Office Action, at items 11 and 26, is asserting that one skilled in the art would be motivated to use the message processing apparatus as discussed in Furusawa to trigger the offer for insurance. DiMattina triggers an offer for insurance every time the user submits an order to the retailer's website. Accordingly, DiMattina teaches away from using the claimed "cross-checking, by a server operated by a service dealer other than a buyer, a seller and an insurance company, electronic information distributed within the server between the buyer and the seller" to trigger distributing solicitation-to-insurance information by being in the context of a buyer on a retailer's website. Therefore, Applicants respectfully submit that one skilled in the art could not have combined or modified DiMattina with Furusawa to include the claimed "cross-checking, by a server operated by a service dealer other than a buyer, a seller and an insurance company, electronic information distributed within the server between the buyer and the seller," and see the benefit of distributing solicitation-to-insurance information to a buyer, a seller or both, when the buyer and seller exchange electronic information on a server operated by a service dealer other than a buyer, a seller and an insurance company.

Accordingly, Applicants respectfully submit that a *prima facie* case of obviousness cannot be based upon DiMattina and Furusawa, because DiMattina, Furusawa and any combination thereof fails to disclose, either expressly or implicitly, the claimed "cross-checking, by a server operated by a service dealer other than a buyer, a seller and an insurance company, electronic

information distributed within the server between the buyer and the seller with a word table in which a solicitation-related keyword is registered, and judging whether the solicitation-related keyword is included in the electronic information; and distributing solicitation-to-insurance information to the buyer, the seller or both, when judged by the server that the solicitation-related keyword is included in the electronic information," as recited, for example, in claim 4.

Applicants respectfully submit that independent claims 6, 9-12 and 20 patentably distinguish over the cited references for similar reasons as independent claim 4.

Dependent claims recite patentably distinguishing features of their own or are at least patentably distinguishing due to their dependence from the independent claims. Withdrawn dependent claims 13-19 are amended to require the same features as the amended elected claims and/or to correct their dependency. It is understood that upon allowance of the elected independent claims, withdrawn dependent claims 13-19 are allowed. Withdrawal of the rejection of pending claims, and allowance of pending claims is respectfully requested.

CONCLUSION

It is respectfully submitted that the foregoing has demonstrated that claims 1-7 and 9-20 patentably distinguish over the references and rejections of record.

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.


Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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Date: July 18, 2007

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